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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,241	04/12/2001	Uwe Sperling	33398	5836
116	7590	10/05/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			NGUYEN, TU T	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/834,241	Applicant(s) SPERLING, UWE	
	Examiner Tu T. Nguyen	Art Unit 2877	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 16 and 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species I (claims 1-12, 14, 16, 19-37) in the reply filed on 07/02/2004 is acknowledged.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

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and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

"Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

+) In the specification, the claim number should not be mentioned.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19,35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1) Claim 19, line 2, "and/or" is indefinite.
- 2) Claims 35-37, the claims are the method claims. However, the claims are depended on an apparatus claim 1. Claims 35-37 lack of structural element.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12,14,16,19-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repschlager et al (4,956,551) in view of Lex (5,923,434).

With respect to claims 1,35, Repschlager discloses a device for measuring properties of objects. The device comprises: a housing 6 (fig 4), an optical measuring base unit 16 (fig 4) comprising at least one measuring means 8 (fig 4) for detecting reflection light 7 (fig 2), at least one retaining means 17-18 (fig 4) for the elastic retention (abstract) of the optical measuring base unit 16 (fig 4).

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Repschlager does not disclose the claimed touchdown means. Lex discloses a system for measuring an object. The system comprises: a touchdown means 103,104 (fig 10) for setting the measuring unit 100 (fig 10) upon a surface 115 (fig 10) to be measured. It would have been obvious to modify Repschlager with the touchdown means as taught by Lex to control the position between the measuring surface and the housing easier.

With respect to claim 2, Lex discloses measuring characteristics of the surface including haze, gloss (column 3, lines 10-15). Since Lex uses a light source 3 (fig 1) and directs light to the measuring surface 8 (fig 1), the claimed measuring the surface at a predetermined wavelength interval would have been inherent.

With respect to claim 3, since Lex's system performs the same function as the claimed invention, it would have been obvious that two or more characteristic parameters of the measurement surface would be ascertainable.

With respect to claims 4-5, Lex does not explicitly disclose how the touchdown connected to the other unit or position between the touchdown in relation to the other unit as claimed. However, it would have been obvious to modify Lex's touchdown means to have different shapes or to be located at different locations for detecting different type of surfaces. The modification involves only routine skill in the art.

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With respect to claim 6, Lex discloses a supporting means 17 (fig 4) performing the same function as claimed.

With respect to claims 7-9,12,16, the claimed guiding means, reset means, alignment means, activating means, spring means would have been known. It would have been obvious to modify Repschlager's system with the known guiding means, reset means, alignment means, activating means, spring means to facilitate the measuring.

With respect to claims 10-11,14,36-37, the skill artisan would have been motivate to modify Repschlager's system with the claimed deactivating means or a warning means or a detecting means for detecting a change in pressure at the measuring surface or for detecting displacement of the measuring base unit to make the system more accurate.

With respect to claim 19, Lex discloses a wheel 103 (fig 10).

With respect to claim 20, Lex discloses at least one source of radiation 111 (fig 10) being directed at a predetermined angle 45 degrees (fig 10).

With respect to claim 21, Lex discloses a housing 1 (fig 10) which can be set down upon the surface 8 (fig 10) to be measured.

With respect to claim 22, Lex discloses at least one part 21,22,24 (fig 3) of the measuring unit 20 (fig 3) protrudes from the housing (fig 2).

With respect to claim 23, Lex discloses the claimed limitation 103,104 (fig 10) (column 10, lines 35-45).

With respect to claims 24-30, it would have been obvious a design choice to modify the housing to encompass different supporting means or modifying Lex's system with a pivoting means to control distance or inclination angle between the measuring surface and the measuring base unit to facilitate the measuring.

With respect to claims 31-33, Since the general conditions of the claimed invention were disclosed by the prior arts, modifying the prior arts to measure a clearance distance or to use a pattern projection means or to measure a tilt of the measuring unit to make the system more accurate involves only routine skill in the art.

With respect to claim 34, Lex discloses intergrating a plurality of measuring devices into one device (column 6, lines 40-45) for measuring different characteristics of the surface. It would have been obvious to modify Repschlager's system with a plurality of measuring devices as claimed for measuring different conditions of the measuring surface as claimed at a same time to save time.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T. Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Toatley Jr. can be reached on (571) 272-2800 Ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu T. Nguyen  
Primary Examiner  
Art Unit 2877



09/28/2004